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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/695,102	10/23/2000	Matthew Jarman	15265.4	2767

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CLEARPLAY, INC
2385 SOUTH 300 WEST
SALT LAKE CITY, UT 84115

EXAMINER

VU, NGOCK

ART UNIT	PAPER NUMBER
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2611

DATE MAILED: 09/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/695,102	JARMAN, MATTHEW
	Examiner	Art Unit
	Ngoc K. Vu	2611

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on _____.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-42 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-7,9-15,17-36 and 38-41 is/are rejected.
- 7) Claim(s) 8,16,37 and 42 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ . |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>01/08/01, 03/04/02</u> | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ . |

DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities: it is noted that all reference numerals described in the specification with respect to figure 1 are not matched with all reference numerals in the drawing. For example, the reference numeral of “computer” is 20 in the specification while it is 120 in the drawing; “processing unit” is 21 in the specification while it is 121 in the drawing...etc. Appropriate correction is required.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 25 and 26 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 30 and 35 of copending Application No. 09/694873. Although the conflicting claims are not identical, they are not patentably distinct from each other because they recite the same scope.

Regarding claim 25, claim 30 of the copending application recites a method comprising steps for:

providing an object store that includes a plurality of navigation objects which can be loaded into a memory of the consumer system, each navigation object defining a portion of the multimedia content that is to be filtered;

using a decoder to determine when the multimedia content decoded by the decoder is within the portions of the multimedia content defied by the plurality of navigation objects;

when multimedia content decoded by the decoder is determined to be within the portion of the multimedia content defined by a particular navigation object, filtering the multimedia content; and

causing the multimedia content to be played at an output device, whereby the multimedia content played at the output device excludes each portion thereof which is filtered in accordance with the plurality of navigation objects.

Regarding claim 26, claim 35 of the copending application recites that the portion codes are time codes.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this

subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 9-12, 15, 17-20, 23-28, 31, 32 and 38-40 are rejected under 35 U.S.C. 102(e) as being anticipated by Iggulden et al. (US 5,333,091 A) (*hereinafter "I '091"*).

Regarding claims **9, 18, 25 and 38**, I '091 discloses in an automatic editing system for enabling a consumer to filter multimedia content (e.g., video/audio content), wherein the system includes a processor 120, a memory 124, a decoder 106-110, and an output device 14 for playing the multimedia content, a method for assisting the consumer to automatically identify portions of the multimedia content that are to be filtered and to thereafter automatically filter the identified portions, e.g., automatically eliminating the identified commercial during playback (see abstract and figure 2), comprising:

creating an object store (the pattern, duration, and/or interval of blank frames) which can be loaded in to a memory of the system, the information including a plurality of events (e.g., B, C, D – see figure 2), each of which defines a portion of the multimedia content that is to be filtered by defining a start position (e.g., point B in figure 2) and a stop position (e.g., point C in figure 2) and an event time for filtering action performed on the portion of the multimedia content defined by the start and stop positions (see col. 4, lines 9-52; col. 6, lines 16-42);

continuously querying for a position code, the position code indicating a position relative to other positions within the multimedia content (e.g., during playback, a decoder continuously receives the encoded data indicating position of the tape in the cassette. The decoder obtains a time code from the video tape during playback. The time code is regarded as a tape position code – see col. 5, lines 48-52; col. 8, lines 45-66; col. 11-12, lines 68-4; and figure 2);

continuously monitoring the position code and comparing it with the event time to determine if there is indexed event relating to the current position of the tape (see col. 8-9, lines 8-2);

when the position code is determined to be within an event, scanning past action assigned to the event in order to filter the multimedia content for that portion defined by the point (see col. 4, lines 9-52; col. 10, lines 23-34); and

transferring the multimedia content to an TV 14, wherein the multimedia content is played at the output device excluding each portion thereof which is filtered in accordance with the plurality of points (during playback, the stored data for each event is compared to the timing reference data read from the tape and the VCR is automatically commanded into a fast scan mode when the tape reaches the beginning time of a portion of the video signal that has been determined for elimination during playback. The VCR is then automatically commanded to return to the normal “play” mode when the tape reaches the ending time of that portion of the video signal. The TV screen be blanked while the VCR is in the fast scan mode – see col. 3, lines 49-62; col. 4, lines 9-20; col. 7, lines 18-40 and figure 2).

Further regarding **claims 38-40**, they call for computer readable medium for carrying machine-executable instructions for implementing method. It is noted that the method of I ‘091 should be automating method steps in software to automate the editing system and provide computer control.

Regarding claims **10 and 17**, I ‘091 explicitly discloses that the VCR plays the program in play mode until the tape reaches the position corresponding to event B. Since the video signal between events B and C has been determined as commercial material, the VCR is commanded

into skip mode. When the tape reaches the position corresponding to event C, the VCR remains in the skip mode since the video signal between events C and D has also been determined as commercial material. When the tape has advanced to the position corresponding to event D, the VCR is commanded back to the play mode for normal viewing of the program material between events D and E. It is further noted that once the time code or tape position code interval is calibrated during normal play, the time code will provide will provide an accurate measure of time relative to the recorded video signal for comparison with the stored event times (see col. 4, lines 39-52; col. 8, lines 49-66).

Regarding claims **11, 19, 26 and 39**, I '091 discloses that the position codes are time codes (see col. 8, lines 50 to col. 9, line 14; col. 11, line 64 to col. 12, line 4).

Regarding claims **12, 20, 27 and 40**, I '091 discloses skipping the portion of the multimedia content, e.g., commercial message, defined by the event (see col. 4, lines 16-20 39-49).

Regarding claims **15, 23 and 31**, I '091 discloses determining the time interval between the events if it is less than five minutes (see col. 10, lines 13-17).

Regarding claims **24 and 32**, I '091 discloses scanning or skipping the events in the video signal (see col. 4, lines 9-23 and 39-52).

Regarding **claim 28**, I '091 discloses that the decoder is located at the consumer's computer system (see figure 2).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-3, 5-7, 14, 22, 30 and 33-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Iggyulden et al. (US 5,333,091 A) (*hereinafter “I ’091”*).

Regarding claims **1 and 33**, I ’091 discloses in an automatic editing system for enabling a consumer to filter multimedia content (e.g., video/audio content), wherein the system includes a processor 120, a memory 124, a decoder 106-110, and an output device 14 for playing the multimedia content, a method for assisting the consumer to automatically identify portions of the multimedia content that are to be filtered and to thereafter automatically filter the identified portions, e.g., automatically eliminating the identified commercial during playback (see abstract and figure 2), comprising:

creating an object store (the pattern, duration, and/or interval of blank frames) which can be loaded in to a memory of the system, the information including a plurality of events (e.g., B, C, D – see figure 2), each of which defines a portion of the multimedia content that is to be filtered by defining a start position (e.g., point B in figure 2) and a stop position (e.g., point C in figure 2) and an event time for filtering action performed on the portion of the multimedia content defined by the start and stop positions (see col. 4, lines 9-52; col. 6, lines 16-42);
the position code is determined to be within an event, scanning past action assigned to the event in order to filter the multimedia content for that portion defined by the point (see col. 4,

lines 9-52; col. 10, lines 23-34); and transferring the multimedia content to an TV 14, wherein the multimedia content is played at the output device excluding each portion thereof which is filtered in accordance with the plurality of points (during playback, the stored data for each event is compared to the timing reference data read from the tape and the VCR is automatically commanded into a fast scan mode when the tape reaches the beginning time of a portion of the video signal that has been determined for elimination during playback. The VCR is then automatically commanded to return to the normal “play” mode when the tape reaches the ending time of that portion of the video signal. The TV screen be blanked while the VCR is in the fast scan mode – see col. 3, lines 49-62; col. 4, lines 9-20; col. 7, lines 18-40 and figure 2).

I ‘091 does not explicitly disclose retrieving the multimedia content to be played at the consumer in response to a request. Official Notice is taken that providing a video program from a provider in response to a subscriber’s request is well known in the art. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system of I ‘091 by providing a video program from a provider in response to a subscriber’s request in order to enhance the television system.

Further regarding claims 33-35, they call for computer readable medium for carrying machine-executable instructions for implementing method. It is noted that the method of I ‘091 should be automating method steps in software to automate the editing system and provide computer control.

Regarding claims 2 and 34, I ‘091 discloses that the position codes are time codes (see col. 8, lines 50 to col. 9, line 14; col. 11, line 64 to col. 12, line 4).

Regarding claims **3 and 35**, I '091 discloses skipping the portion of the multimedia content, e.g., commercial message, defined by the event (see col. 4, lines 16-20 39-49).

Regarding **claims 5, 14, 22 and 30**, I '091 does not explicitly disclose receiving a fee from a user to access the server system for a specific period of time. Official Notice is taken that paying a fee at a subscriber's terminal for authorizing viewing a movie for a specific period of time is well known in the art. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system of I '091 by paying a fee at the viewer's terminal for authorizing viewing a movie for a specific period of time.

Regarding **claim 6**, I '091 discloses determining the time interval between the events if it is less than five minutes (see col. 10, lines 13-17).

Regarding **claim 7**, I '091 explicitly discloses that downloading detectable events in the video signal during playing back the video. Data for each pair of events is tested so that each inter-event interval is assigned either a scan start flag or a resume play flag to control operation of the VCR such as scanning or playing during playback (see col. 10, lines 44-47).

Claims 4, 13, 21, 29, 36 and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Iggleston et al. (US 5,333,091 A) (*hereinafter "I '091"*) in view of Iggleston (US 6,002,443 A) (*hereinafter "I '443"*).

Regarding **claims 4, 13, 21, 29, 36 and 41**, I '091 does not disclose muting audio content for the portion of audio content. However, I '443 discloses a method for muting the audio portions of the television signal during each unwanted segment such as commercial segment (see abstract and col. 10, lines 5-19). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of I '091 by muting the audio

portions of the television signal during each unwanted segment as disclosed by I'443 for purpose of muting the unwanted broadcast material without a human operator.

Allowable Subject Matter

8. Claims 8, 16, 37 and 42 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The prior art of record does not teach or suggest the limitations “sending a representation of the one or more navigation objects to the consumer system, the representation including a description of the one or more navigation objects; receiving a password from the consumer system to authorize disabling at least one of the one or more navigation objects; receiving a response to the representation of the one or more navigation objects sent to the consumer system, the response identifying the at least one of the one or more navigation objects to be disable; and disabling the at least one of the one or more navigation objects such that the filtering action assigned by the at least one of the one or more navigation objects is ignored”.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

August et al. (US 6,100,916 A) discloses a system and method for blocking of individual programs and/or portions of programs.

Ostrover (US 6,351,596 B1) discloses a method and system for determining scenes to be skipped and the starting point of any scene that is to follow a scene that is to be skipped.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ngoc K. Vu whose telephone number is 703-306-5976. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Grant can be reached on 703-305-4755. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Ngoc K. Vu
Examiner
Art Unit 2611

September 3, 2004